In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

THE GOODYEAR TIRE & RUBBER COMPANY, PETITIONER

v.

THE COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

The Weather-Rite Sportswear Company made application to the Patent Office for the registration of the trade-mark, "Goodyear Deluxe By Weatherite".[1] After some correspondence and amendments by Weather-Rite to its application,[2] the patent examiner,

[1] In 1888 this Court, in *Goodyear's India Rubber Glove Manufacturing Co.* v. *Goodyear Co.*, 128 U.S. 598, held that "Goodyear Rubber" was merely descriptive of the rubber produced by Goodyear's process, *i.e.*, vulcanized rubber, and was not subject to exclusive appropriation. In the years since that decision, the term "Goodyear" has been used in the trade-marks of numerous companies other than petitioner. *E.g.*, R. 93–97, 109–116.

[2] The original application had been for the mark "Goodyear by Weatherite," and this was changed in one of the amendments.

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upon re-examination, decided that Weather-Rite was entitled to the registration sought, and the Commissioner, in accordance with 15 U.S.C. 1062, thereupon had the proposed mark published in the *Official Gazette*. No opposition was filed within thirty days after publication—the prerequisite, under 15 U.S.C. 1063, to instituting an opposition proceeding. After the period for the filing of oppositions had expired, the Patent Office discovered that the specimen that had been submitted with the application was not one of the goods specified in the amended application, as required by Rule 2.56 of the Patent Office, 37 C.F.R. 2.56, and accordingly ordered the application re-examined. Weather-Rite promptly submitted corrected specimens,[3] and the examiner found the mark to be entitled to registration without need for republication.

Although petitioner had long been aware of the application for registration (*e.g.*, Pet. 6), it waited until the afternoon of November 23, 1964—the day before the trade-mark was to issue—to file an application in the district court for a temporary restraining order (R. 71–74), which it obtained *ex parte* at 4:00 p.m. that day (R. 74–75). Shortly thereafter, petitioner amended the complaint it had filed in the district court with its application for a temporary restraining order to request, for the first time, that the Patent Office republish the trade-mark to permit peti-

[3] Contrary to petitioner's suggestion (Pet. 5), a specimen of each of the goods set forth in the application is not required by the Patent Office rules. Rule 2.21, 37 C.F.R. 2.21.

tioner to file an opposition (R. 75–76). The district court granted summary judgment for the Commissioner (238 F. Supp. 509 (D.D.C.)), and the court of appeals affirmed *per curiam* (355 F. 2d 109 (C.A. D.C.)).

The sole issue here is whether Rule 2.81 of the Patent Office (Pet. App. 16a–17a), 37 C.F.R. 2.81, required that the mark be republished after Weather-Rite submitted the corrected specimens. Rule 2.81 provides:

> If, on examination or re-examination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition.

In compliance with this rule, the mark here was published after re-examination, when the examiner believed that the applicant was entitled to have his mark registered. The subsequent furnishing of new specimens was clearly not a ground upon which petitioner could oppose registration of the mark,[4] and no amendment was made to the application for registration or to the mark itself that could have provided a new ground for opposition. In these circumstances, the Patent Office has consistently, and quite properly, refused to expose an applicant to a second thirty-day

[4] Lack of proper specimens is not a proper ground for opposition. It is a matter easily correctible and in any event one as to which an opponent would have no ground for complaint. That is why such lack is regarded by the Patent Office as a matter that can properly be considered on an *ex parte* basis.

period for opposition. Cf. *Carter Medicine Co.* v. *Barclay*, 36 App. D.C. 123; *Wilson* v. *Delaunay*, 245 F. 2d 877 (C.C.P.A.). No purpose would be served thereby. Rule 2.81 and the underlying statute, 15 U.S.C. 1062, require only that a proposed mark be subjected once to the thirty-day period for opposition. Hence, unless changes are made in the application that would give potential objectors a ground for opposition that did not exist at the time of the first publication, republication is unnecessary to comply with rule and statute. Having failed to oppose within the permitted time period, petitioner is remitted to its remedies of a cancellation proceeding (15 U.S.C. 1064) or a suit for unfair competition and/or trade-mark infringement (15 U.S.C. 1119)—remedies which, as the district court pointed out (Pet. App. 3a), are perfectly adequate, and unaffected by petitioner's failure to oppose within the prescribed time limit.

The decision below is clearly correct and further review is not warranted.[5] The petition for a writ of certiorari should therefore be denied.

Respectfully submitted.

THURGOOD MARSHALL,
Solicitor General.

APRIL 1966.

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[5] The conflict between the court of appeals below and the Court of Customs and Patent Appeals alleged by petitioner (Pet. 9) has no relevance to this case, where the only question is the meaning of Rule 2.81, not the presumption of correctness—the issue in the cited cases. As to the alleged admission of inconsistency by the Solicitor of the Patent Office (Pet. 9), we find no basis for the allegation in the record, either at the page cited in the petition or elsewhere.

U.S. GOVERNMENT PRINTING OFFICE: 1966